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In re Application of
JEFF A. ZABLOCKI et al.
Serial No.: 09/980,533
PCT No.: PCT/US00/32721
Int. Filing Date: 01 December 2000
Priority Date: 03 December 1999
Attorney's Docket No.: 99,913-X
For: PARTIAL OR FULL A1AGONISTS
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DECISION ON PETITION

UNDER 37 CFR 1.137(b)

and 37 CFR 1.182

This is a decision on applicant's "Petition under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office (USPTO) on 01 November 2001. On 19 February 2002, at the request of the undersigned, applicant also filed a request to correct the International application number which appeared on the transmittal letter filed 01 November 2001 in the above identified patent application.

BACKGROUND

On 01 December 2000, applicant filed international application No. PCT/US00/32721 with the United States Receiving Office, which claimed priority to 03 December 1999. On 29 June 2001, a Demand was filed, extending the deadline for entry into the national stage to 30 months or to 03 June 2002.

On 01 November 2001, applicant filed a Transmittal Letter requesting entry into the national stage incorrectly identified PCT application number PCT/US01/32721, rather than PCT/US00/32721. The request was assigned application no. 09/980,533. A Patent Data Sheet accompanied the papers. Applicant also filed the instant petition to revive under 37 CFR 1.137(b) which identified PCT/US00/32721.

On 19 February 2002, applicant filed a request to correct the international application number as identified on the transmittal letter, which is treated as a petition under 37 CFR 1.182. The request, in effect, asks for correction of the international application number in the 01 November 2001 transmittal letter from PCT/US01/32721 to PCT/US00/32721. Applicant also filed a replacement page 1 of the transmittal letter.

DISCUSSION

As explained at Section 1893.03(a) of the Manual of Patent Examining Procedure (MPEP), any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

On 01 November 2001, applicant filed a Transmittal Letter to the United States Designated/Elected Office Concerning A Filing under 35 U.S.C. 371 (Form PTO-1390). In an accompanying paper entitled "Patent Data Sheet", applicant made reference to "continuation of PCT/US00/32721, Filing Date 01 December 2000". Applicant did not provide the basic national fee for entry into the national stage in the USPTO. Therefore, due to the conflicting instructions, the papers filed on 01 November 2001 are considered a U.S. application under 35 U.S.C. 111(a).

The transmittal letter, at issue herein, was filed on 01 November 2001 with the DO/EO/US, within the thirty month time limit under Article 39(1)(a) (which time limit expired after midnight of 03 June 2002) and as such is acceptable under Article 31. The continuation application of PCT/US00/32721 will be considered as having been filed on 01 November 2001.

Applicant's petition to revive and request to correct the international application number on the request for entry into the U.S. national stage in PCT/US00/32721 are considered moot as the payment of the basic national fee for entry into the U.S. national stage is not required since the application is considered to have been filed under 35 U.S.C. 111(a). Therefore, the petition fee of \$620 will be refunded to applicant.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/980,533) and the international application (PCT/US00/32721) designating the United States were copending on 01 November 2001. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application with the statement: "The present application is a continuation of international application PCT/US00/32721, filed 01 December 2000."

CONCLUSION

For the reasons above, applicants' submission on 01 November 2001 will be treated as an application filed under 35 U.S.C. 111(a), with a filing date of 01 November 2001. Applicant's petition to revive and request to correct the international application number on the request for entry into the U.S. national stage in PCT/US00/32721, originally filed with the DO/EO/US on 01 November 2001 is considered **MOOT**.

Applicant's deposit account has been credited the petition to revive fee of \$620.

This application is being forwarded to Office of Initial Preliminary Examination (OIPE) for further processing. The application will then be forwarded to Art Unit 1614.



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